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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.
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09/250,711 02/16/99 KIGHT

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EXAMINER

TM02/0808

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BERGIN, J

ART UNIT

PAPER NUMBER

2164

DATE MAILED:

08/08/01

Please find below and/or attached an Office communication concerning this application or proceeding.

Commissioner of Patents and Trad marks

Office Action Summary

Application No.

09/250,711

Applicant(s)

RIGHT ET AL.

Examiner

James S. Bergin

Art Unit

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 31 May 2001.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-5, 21, 25, 34, 35, 38-41, 44, 45, 48-51, 54, 56, 59, 60 and 62-67 is/are pending in the application.
- 4a) Of the above claim(s) 1-5, 34, 35, 59, 60 and 62-67 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 21, 25, 38-41, 44, 45, 48-51, 54 and 56 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☒ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____
- 4) ☐ Interview Summary (PTO-413) Paper No(s). _____
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____

DETAILED ACTION***Election/Restrictions***

1. Applicant's election with traverse of Group II, species 1 (the hardware configuration of figure 5), claims 21, 25, 38-41, 44, 45, 48-51, 54 and 56, in Paper No. 16 is acknowledged. The traversal is on the ground(s) that the examiner has not met the burden of providing a reasonable example that recites material differences between the method of group I and the system and article of manufacture of group II. This is not found persuasive because the examiner has in fact provided the reasonable example of the method of group I possessing the capability of being performed in the absence of a computer, such as by an account representative, a telephone network and a telephone. The steps of "processing" and "generating" can properly be interpreted in a much broader sense such that they could include processing and generation functions by a human operative or mechanical machine rather than a computer. As such, the search for group I is substantially broader than that of group II, (even though the two inventive groups have been properly classified in the same class/ subclass), group II being further limited by first and second processors and computer readable medium containing thereon the instructions for performing a payment method. This disparity in the search required between the two groups would place an excessive burden on the examiner. Hence the restriction requirement.

The requirement is still deemed proper and is therefore made FINAL.

Claim Rejections - 35 USC § 112

2. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

3. Claims 44 and 54 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

In claims 44 and 54 it is unclear how the first the second accounts entities can be the same deposit account entity? (Note that claims 44 and 54 depend from claims 41 and 51 respectively, in which claims both first and second accounts have been specifically claimed).

Claim Rejections - 35 USC § 103

4. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

5. Claims 21, 25, 38-41, 44, 45, 48-51, 54 and 56 are rejected under 35 U.S.C. 103(a) as being unpatentable over Lawlor et al. (5,220,501) in view of Benton et al. (5,265,008).

Lawlor et al. teaches a method of paying bills using a computer comprising receiving requests via a network to pay bills of merchants on behalf of consumers (see abstract, figures 12, 14a-14d); determining a consumer's account number from a database (column 33, lines 3-60, column 31, lines 50-58) and paying a plurality of bills

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of each of a plurality of consumers by a single consolidated or aggregated payment such as a check or electronic funds transfer (column 33, line 63 – column 34, line 4).

Lawlor teaches that the customer's bills are paid to a service provider's account and that the service provider then pays the merchant (col. 19 lines 9-11, col. 23 lines 34-38, col. 49 lines 7-28). Lawlor further teaches detecting duplicate requests to pay a bill (col. 43 lines 58-68) and teaches that funds can be directly transferred from the consumer's account to the ultimate payee's account (col. 49 lines 20-28).

Lawlor teaches accessing the merchant's bank routing number necessary for an electronic funds transfer, determining a consumer's deposit account and preparing a draft or electronic funds transfer on funds in that account. See the sections of Lawlor cited above (see also col. 42 line 60 to col. 43 line 68, col. 49 lines 7-40).

Lawlor teaches selecting a payment type from a group consisting of a first payment type and a second payment type and directing payment of the bill using the selected payment type (col. 20 lines 59-67, col. 33 lines 3-60 particularly lines 15-16 and 55-57). Lawlor also teaches that the first payment type is an electronic funds transfer, the second payment type includes a check and that the payment type is determined by accessing a database of merchant information and determining the payment type for that merchant.

With respect to the recitation of an article of manufacture comprising a computer readable medium and software, as the system of Lawlor is a computer system, its operation is seen to be inherently directed by a computer readable medium storing software.

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Lawlor et al. also teach debiting the consumers' accounts in order to pay the bills (column 19, lines 9-11, column 23, lines 34-38, column 49, lines 7-28). Lawlor et al. teach that bill payment to the merchants is performed over the ACH network (column 49, lines 34-40).

Lawlor et al. fail to explicitly teach generation of a directive to debit each consumer account via an ACH network. Lawlor et al. teach utilization of ATM transfer for this purpose.

However, Benton et al. (5,265,008) discloses that in the interests of economy, various electronic and computer based arrangements have been suggested and used in an attempt to perfect electronic funds transfer. Some examples are electronic funds transfer techniques that have achieved substantial usage in recent years such as Automated Clearing House (ACH), Automated Teller Machine (ATM), and point of sale system (POS) (see Benton et al., column 1, lines 20-29). Benton et al. is being applied only to show evidence of the ubiquitously well-known nature of ACH and ATM methods of electronic funds transfer at the time that the invention was made.

Thus, it would have been obvious, in view of the state of the art disclosed by Benton et al., to one of ordinary skill in the art at the time that the invention was made to modify the teachings of Lawlor et al. to debit consumer accounts via ACH as a matter of substitution of art recognized equivalents or alternately to make use of the same ACH network that Lawlor et al. were already using for paying the merchant.

Concerning the limitations of first and second processors in the applicant's claim 25, the examiner takes official notice that networked computer systems usually contain

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a plurality of processors for performing various networking and application tasks, the number of processors being determined by system design and cost considerations.

Thus it would have been obvious to one of ordinary skill in the art at the time that the invention was made to select a plurality of processors in the Lawlor et al. computer system, including the possibility of selecting just a first and a second processor, the precise number of processors selected being dependent on system design and cost considerations.

Regarding claims 41, 44, 51 and 54, the transfer of funds from the plurality of consumers deposit accounts into a second deposit account associated with the service provider is not considered to patentably distinguish over Lawlor et al.

The examiner takes official notice that financial service providers can have a plurality of internal deposit account structures for holding funds based on any one of a myriad of criteria, including internal accounting and financial management design or practice strategies.

Thus, the precise number of deposit accounts selected at the service provider, whether it be one, two or more, would have been obvious to one of ordinary skill in the art at the time that the invention was made, such a selection being determined by routine internal accounting and financial management design or practice strategies within the bill paying service provider. If the applicant disagrees with this position, then an election of species requirement will be made between an embodiment wherein the bill paying service provider has one deposit account for receiving funds from the

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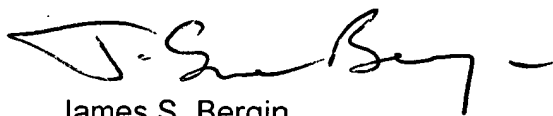
plurality of consumers, and an alternative embodiment wherein the service provider comprises a first and a second such deposit accounts.

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to James S. Bergin whose telephone number is 703 308-8549. The examiner can normally be reached on Monday-Thursday 8.30-6.00 and on alternate Fridays.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Vincent Millin can be reached on 703 308-1065. The fax phone numbers for the organization where this application or proceeding is assigned are 703 308-1396 for regular communications and 703 308-1396 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703 305-3900.



James S. Bergin

Examiner
August 1, 2001



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SUPERVISORY PATENT EXAMINER
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